



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,372	06/29/2000	Toshiaki Saito	862.C1936	7361

5514 7590 03/17/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

REITZ, KARL

ART UNIT	PAPER NUMBER
----------	--------------

2624

DATE MAILED: 03/17/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,372

Applicant(s)

SAITO ET AL.

Examiner

Karl R. Reitz

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2000.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

2. Figure 4 is objected to because the arrow indicating the flow of data is pointing in the wrong direction (the detailed description of figure 4 is given on pages 17 and 18). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

3. The co-pending application cited in the information disclosure statement has a later filing date than the application. It therefore cannot be relied upon and should not be cited in an information disclosure statement. If it is a related co-pending application that is to be incorporated by reference, it should be cited in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8, 17 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeda (5,485,282).

Art Unit: 2624

6. In accordance with claim 8, Takeda discloses an image communication apparatus with notification means, RDCLP (from communication controller 2), for notifying the transmitting side of information declaring that image data of a main scanning size not more than a main scanning size defined by the recommendation can be received (col. 4 lines 28-31).

7. Takeda further discloses extraction means 9 for extracting valid area of image data transmitted from the transmitting side in response to the notification from said notification means (col. 4 lines 6-8).

8. In accordance with claim 17, the method steps of claim 17 are all performed by the means of the apparatus of claim 8. The notification means RDCLP and extraction means 9 of claim 8, respectively, perform the notification and extraction steps of claim 17.

9. In accordance with claim 22, Takeda discloses using a program to stored in ROM to operate the apparatus (col. 3 lines 24-26). The notification and extraction modules, of claim 22 are performed in the notification and extraction steps of claim 17, respectively.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed

before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 9, 18, 23 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Murai (6,005,673).

12. In accordance with claim 9, Murai discloses an image communication apparatus with printing means 3 (figure 1) for printing a color image on the basis of an image signal (col. 6 line 35).

13. Murai further discloses determination means CPU 29A, for determining color-printing capability of the printing means 3; in Murai's system, the CPU executes a program according to the flowchart of figure 9 (col. 8 lines 19-20). In S3 of figure 9, a determination of the printing capability is determined (col. 13 lines 19-24) by the CPU 29A.

14. Murai further discloses transmission means DIS (via modem 25) for transmitting information about the color printing capability determined by the determination means to a transmitting side using a control signal based on the recommendation; in Murai's system, the transmitting side uses information sent from the receiving side in the DIS signal according to standards (col. 12 lines 28-30) to obtain functional information (in step 1 of figure 9) regarding the color printing capabilities of the receiving side (col. 13 lines 11-16).

15. In accordance with claim 18, the method steps of claim 18 are all performed by the means of the apparatus of claim 9. The printing means 3, determination means 29A and transmission means DIS (via modem 25) of claim 9, respectively, perform the printing, determination and transmission steps of claim 18.

Art Unit: 2624

16. In accordance with claim 23, Murai discloses using a program to stored in ROM to operate the apparatus (col. 7 lines 65-67). The printing, determination and transmission modules, of claim 23 are performed in the printing, determination and transmission steps of claim 18, respectively.

17. In accordance with claim 10, Murai discloses that the determination means 29A determines the color printing capability in accordance with a type of color ink set and a type of printing medium in the printing means; in Murai's system the determining means obtains information regarding all the data as shown in figure 3 (col. 10 lines 24-30), which includes paper size and the output system, which in turns specifies the type of printer used and its inks (col. 10 lines 61-63).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 11, 19, 2, 12, 3, 13, 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda in view of Ohki (5,757,965) in further view of Shibata (5,835,923).

20. In accordance with claim 1, Takeda discloses an image communication apparatus 1 with original read means 6 (figure 1) for generating image data by reading an original image (col. 3 lines 33-36).

Art Unit: 2624

21. Takeda further discloses identification means 9 for identifying a size of the original image read by the original read means (col. 3 lines 38-40).

22. However, Takeda does not disclose expressly that the apparatus has a compression means for compressing image data.

23. Ohki discloses an apparatus with compression means 7 (figure 1) for compressing image data (col. 3 line 24).

24. Takeda and Ohki are combinable because they are from the same field of endeavor, namely size discriminating image reading and image processing.

25. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to add a compression means to Takeda's system, as described by Ohki.

26. The motivation for doing so would have been to decrease the size of the image thereby a) reducing the time of transmission and b) reducing the amount of storage required in the apparatus, thus saving costs.

27. Takeda further discloses that when the paper size of the original is different from the recommended sizes, the apparatus, in step 32 of figure 9, selects the closest paper size available to print the image on (col. 7 lines 51-54).

28. Ohki discloses performing control to set valid image area of the image data compressed in accordance with the size of the original image when the image data is compressed and transmitted; in Ohki's system valid image area is defined in header (frames 21 to 23 of figure 2) (col. 3 lines 31-36).

Art Unit: 2624

29. However, Neither Takeda or Ohki discloses a control means for, when the size of the original image is smaller than a page size defined by the recommendation, causing the reader to add invalid data to make the image data have a page size equal to the page size defined by the recommendation,

30. Shibata discloses the addition of invalid data to make the image data have a page size equal to the page size defined by the recommendation (col. 14 lines 58-61 and as shown in figure 5(b)).

31. Shibata is combinable with Takeda and Ohki because they are from the same field of endeavor, namely image processing and communication.

32. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to cause the reader 6 of Takeda's system to, perform as control means by adding blank data, in the form of zeroes, to blank image areas, as disclosed by Shibata.

33. The motivation for doing so would have been to a) format the image area properly, thus placing the image data in the desired location of the paper b) ensure that the image data being sent conforms to standards page sizes for image data and c) avoid the requirement of separation address information for each sub-section to be processed (Shibata: col. 14 lines 61-63).

34. In accordance with claim 11, the method steps of claim 11 are all performed by the means of the apparatus of claim 1. The identification means 9, compression means 7 and control means 6 of claim 1, respectively, perform the identification, compression and control steps of claim 11.

Art Unit: 2624

35. In accordance with claim 19, Takeda discloses using a program to stored in ROM to operate the apparatus (col. 3 lines 24-26). The identification, compression and control modules, of claim 19 are performed in the identification, compression and control steps of claim 11, respectively.

36. In accordance with claims 2 and 12, Shibata discloses that the invalid data is blank data, in the form of zeroes (col. 14 lines 58-61 and as shown in figure 5(b)).

37. In accordance with claims 3 and 13, the combination of Takeda and Shibata makes obvious the addition of blank data by the reading means 6, while the read means reads the image data in the main scanning direction. Takeda's read means 6, reads the original image and converts it into image data (col. 3 lines 33-36). Shibata discloses adding blank data to a smaller image so that it fits a standard page size (col. 14 lines 58-61 and as shown in figure 5(b)). Thus their combination, as described above, would result in the addition of blank data, as described by Shibata, during the reading process as described by Takeda.

38. In accordance with claims 4 and 14, Ohki discloses that the compression means performs JPEG compression (col. 8 lines 35-38). Ohki further discloses that the image area is set in comments in the JPEG header; in Ohki's system, area is set by the vertical size frame 21 and horizontal size frame 22 in the header (col. 3 lines 31-38 and figure 2).

39. Claims 5, 15, 20, 6 and claims 7, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda in view of Ohki.

Art Unit: 2624

40. In accordance with claim 5, Takeda discloses an image communication apparatus 1 with original read means 6 (figure 1) for generating image data by reading an original image (col. 3 lines 33-36).

41. Takeda further discloses identification means 9 for identifying a size of the original image read by the original read means (col. 3 lines 38-40).

42. However, Takeda does not disclose expressly that the apparatus has a compression means for compressing image data.

43. Ohki discloses an apparatus with compression means 7 (figure 1) for compressing image data (col. 3 line 24).

44. Takeda and Ohki are combinable because they are from the same field of endeavor, namely size discriminating image reading and image processing.

45. Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art, to add a compression means to Takeda's system, as described by Ohki.

46. The motivation for doing so would have been to decrease the size of the image thereby a) reducing the time of transmission and b) reducing the amount of storage required in the apparatus, thus saving costs.

47. Takeda further discloses that when the paper size of the original is different from the recommended sizes, the reader 6 reads the image in the size of the original image; in Takeda's system, the original is read and stored in memory, its size is then compared with standard sizes (col. 4 lines 4-8).

Art Unit: 2624

48. Ohki discloses performing control, which in the combination of Takeda and Ohki would be done by Takeda's reader 6, to designate the size of the original image data once compressed; in Ohki's system valid image area is defined in header (frames 21 to 23 of figure 2) (col. 3 lines 31-36).

49. In accordance with claim 15, the method steps of claim 15 are all performed by the means of the apparatus of claim 5. The identification means 9, compression means 7 and control means 6 of claim 5, respectively, perform the identification, compression and control steps of claim 15.

50. In accordance with claim 20, Takeda discloses using a program to stored in ROM to operate the apparatus (col. 3 lines 24-26). The identification, compression and control modules, of claim 20 are performed in the identification, compression and control steps of claim 15, respectively.

51. In accordance with claim 6, Takeda discloses that the apparatus contains determining means RDCLP, performed by communication controller 2, for determining whether a receiving apparatus has a receiving capability of receiving image data of a size smaller than the page size defined by the recommendation; in Takeda's system the document size and resolution capable of being received on the receiving side is communicated to the sending apparatus by RDCLP via communication controller 2 (col. 4 lines 28-30).

52. Takeda further discloses that the control means designates the size of the image with respect to the receiving apparatus when the receiving apparatus has the capability; in Takeda's system, through the CDCL and RDCLP the sending apparatus sets the

Art Unit: 2624

image size to be printed after communication regarding available paper size from the receiving side (col. 4 lines 34-36 and 46-50).

53. In accordance with claim 7, Takeda discloses an image communication apparatus 1 with identification means 9 for identifying a size of the original image read by the original read means (col. 3 lines 38-40).

54. Ohki further discloses that the apparatus performs JPEG compression (col. 8 lines 35-38) and that the image area is set in comments in the JPEG header; in Ohki's system, area is set by the vertical size frame 21 and horizontal size frame 22 in the header (col. 3 lines 31-38 and figure 2).

55. Takeda further discloses selection means CDS (via communication controller 2) for selecting a printing medium of a size suitable for printing on the basis of the valid image data size identified by the identification means; in Takeda's system the document size and resolution capable of being received on the receiving side is communicated to the sending apparatus via RDCLP (col. 4 lines 28-30), and the sending apparatus sets the image size to be printed after communication regarding available paper size from the receiving side, through the CDCL and RDCLP, and the CDS confirms paper size attributes (col. 4 lines 34-39 and 46-50).

56. In accordance with claim 16, the method steps of claim 16 are all performed by the means of the apparatus of claim 7. The size identification means 9 and selection means CDS of claim 7, respectively, perform the size identification and selection steps of claim 16.

Art Unit: 2624

57. In accordance with claim 21, Takeda discloses using a program to stored in ROM to operate the apparatus (col. 3 lines 24-26). The size identification and selection modules, of claim 21 are performed in the size identification and selection steps of claim 16, respectively.

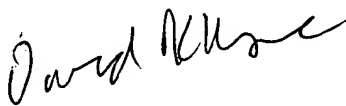
Contact Information

58. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl R. Reitz whose telephone number is (703) 305-8696. The examiner can normally be reached on Monday-Friday 8:00-4:30.

59. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 305-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

60. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KRR


DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600